

allegedly patentably distinct species of claims followed. Instead, the Office Action said that the "patentably distinct species" of claims were "Figure 2, Figure 4, Figure 6, Figure 8, Figure 12 and Figure 15."

The figures of a patent are not the claims of a patent. That the figures might look different does not mean restriction is appropriate.

The March 13, 2006 Office Action is deficient, not only as to the substantive lack of merit of the restriction requirement, but also for failing to comply with the MPEP.

MPEP § 808.01 requires as follows:

"The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given."

"For example, relative to a combination and a sub-combination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not require the particulars of the sub-combination as claimed."

"Each relationship of claimed inventions should be similarly treated and the reasons for the conclusions of distinctness or independence set forth."

None of these requirements were met by the March 13, 2006 Office Action. In fact, the undersigned attorney for the Applicants telephoned the Examiner on March 17, 2006, which was the day on which the March 13, 2006 Office Action was received by him, and attempted to gain the type of guidance required by MPEP § 808.01, but further information and guidance was not provided.

MPEP § 814 requires:

"The examiner must provide a clear and detailed record of the restriction requirement to provide a clear demarcation between restricted inventions so that it can be determined whether inventions claimed in a continuing application are consonant with the restriction requirement and therefore subject to the prohibition against double patenting rejections under 35 U.S.C.

121. Geneva Pharms. Inc. v. GlaxoSmithKline PLC, 349 F.3d 1373, 1381, 68 USPQ2d 1865, 1871 (Fed. Cir. 2003). See also MPEP § 804.01.... “

“The mode of indicating how to require restriction between species is set forth in MPEP § 809.02(a).”

“The particular limitations in the claims and the reasons why such limitations are considered to support restriction of the claims to a particular disclosed species should be mentioned to make the requirement clear.”

None of these requirements were met by the March 13, 2006 Office Action.

MPEP § 817 requires as follows:

“The following outline should be used to set forth a requirement to restrict. (A) Statement of the requirement to restrict and that it is being made under 35 U.S.C. 121 (1) Identify each group by Roman numeral. (2) List claims in each group. Check accuracy of numbering of the claims; look for same claims in two groups; and look for omitted claims. (3) Give short description of total extent of the subject matter claimed in each group, pointing out critical claims of different scope and identifying whether the claims are directed to a combination, sub-combination, process, apparatus, or product. (4) Classify each group.”

The March 13, 2006 Office Action complied with none of these requirements. Specifically, the March 13, 2006 Office Action did not identify each group by Roman numeral, it did not list claims in each group (as pointed out above, it only listed figures), it did not give any description of extent of the subject matter claimed in each group, pointing out critical claims of different scope and identifying whether the claims are directed to a combination, sub-combination, process, apparatus, or product, and it did not classify each group.

As pointed out in the March 17, 2006 telephone conference by Applicants' attorney, the Office Action having failed to comply with the PTO's own guidelines for restriction requirements, Applicants are now left only to guess at what might have been a rationale for the restriction requirement.

The fact that the present application contains thirty-nine claims is insufficient to support restriction. Instead, restriction is authorized only “If two or more independent and

distinct inventions are claimed in one application....” 35 U.S.C. § 121. According to MPEP § 802.01, “distinct” is understood by the U.S.P.T.O. to mean that two or more subjects are disclosed and are novel and unobvious over each other.

Applicants neither admit nor deny that any of there are “independent and distinct” invention claimed. No sufficient reasons or examples have been provided by the March 13, 2006 Office Action in support of restriction, notwithstanding at least the following requirements:

- MPEP § 803 – “Examiners must provide reasons and/or examples to support conclusions....”
- MPEP § 806.05(e) – “The burden is on the examiner to provide reasonable examples that recite material differences.”
- MPEP § 816 – “The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.”

Additionally, the March 13, 2006 Office Action has not explained why the provisions of MPEP § 806.03 are inapposite of the present application. Such provisions prescribe, “Where the claims of an application defined the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.” If it is urged that the claims of the present invention are not but different definitions of the same disclosed subject matter, no explanation of such an assessment has been provided by the March 13, 2006 Office Action.

MPEP § 806.04(f) provides:

"Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that the claims to be restricted to different species must recite the mutually exclusive characteristics of such species."

The March 13, 2006 Office Action does not explain reasoning for the proposition that any of the pending claims recite the mutually exclusive characteristics.

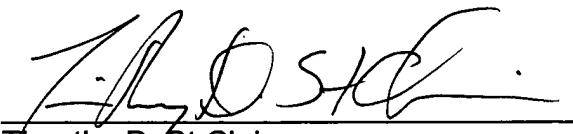
Finally, it has not been shown that restriction is required because otherwise a serious burden would weigh upon the Examiner. As provided by MPEP § 803, "There must be a serious burden on the examiner if restriction is required."

For the foregoing reasons, Applicants request reconsideration and withdrawal or modification of the restriction requirement.

Respectfully submitted,

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